

Remarks

Reconsideration and allowance of the subject patent application are respectfully requested.

Claims 202, 214, 222, 230 and 236 are not rejected. Applicant makes no comments with respect to these claims other than to respectfully request that these claims be identified as containing allowable subject matter in the next office action.

Claims 195, 196, 198, 201, 204-212 and 216-220, 226-228 and 234<sup>1</sup> were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over "UCOPIA: Ucopia Unveils New Wedding Registry Partners ..." (the "Ucopia document") in view of Smutko ("Bridal Business can be the Icing on your cake ...", Chilton's Hardware Age, v 230, n11, page 33(3), Nov. 1993) ("Smutko").

Independent claim 195, 207, 208 and 209 are directed, among other things, to enabling a plurality of gift givers to each make a respective commitment for a monetary contribution of *any giver-desired amount* toward a purchase price of a gift for a gift recipient. An illustrative implementation of this "partial purchase" feature is described, for example, on pages 24-26 of the subject application and permits a plurality of gift-givers to each make a contribution toward a gift. Significantly, in accordance with the methods and systems set forth in these claims, each gift giver can make a commitment for *any giver-desired portion* of the remaining balance of a gift. See, *e.g.*, claim 195, ll. 18-20 ("...wherein the commitment of each giver that commits to make a monetary contribution is for *any giver-desired portion of the uncommitted balance* of the selected gift's purchase price").

The Ucopia system provides a "group purchase" feature in which

[c]ouples designate an item for group purchase on their registry form and specify the dollar amount of shares to be sold. Typically, a share is \$50. Individual guests can then purchase one or more shares. The gift remains on the couple's registry until it is fully purchased. If the full purchase price is not reached, the couple may either purchase the remaining shares

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<sup>1</sup> Although not identified in this statement of the rejection, the body of the rejection also addresses claims 224, 225, 232, 233, 238 and 239. See Office Action, page 8. As such, Applicant assumes that these claims should have been included in the statement of the rejection. Clarification in this regard is respectfully requested should this rejection be maintained.

or obtain a gift certificate to the retailer for the total amount of the shares already purchased. *Ucopia website, Frequently Asked Questions*

The Ucopia document does not disclose (or even suggest) a method or system in which each giver can commit to make a monetary contribution for any giver-desired portion of the uncommitted balance of the gift's purchase price. In the Ucopia system, the commitment of each giver that commits toward the purchase of a gift is constrained by the share price specified for that gift. Thus, a user may not contribute \$25 or \$75, for example, toward the purchase of a gift whose share price has been set to \$50. In complete contrast to the Ucopia system, the arrangements of claims 195, 207, 208, and 209 permit a gift giver to contribute as much or as little as he or she wants. This results in greater convenience for gift recipients, and maximizes the amount of gifts received. For example, a gift giver wishing to spend \$75 can spend exactly \$75.

The "group buy" disclosed in Smutko is alleged to remedy the deficiencies of the Ucopia document. Specifically, the office action alleges:

Smutko teaches that in a group buy a plurality of givers (Gift buyers) each giver that commits to make a monetary contribution is for any giver-desired portion of the uncommitted balance of the gift's purchase price (this is inherent since Smutko, like in any group giving situation discloses a required process of recording commitment of each giver). Smutko, also, require that the price information communicated to and commitments from each giver be expressed in terms of monetary amounts (dollars and cents).

The limited disclosure of Smutko does not detail exactly how the "group buy" is implemented and for this reason alone Applicants submit that its proposed combination with the Ucopia document would not have resulted in the subject matter of any of the rejected claims. In addition, Smutko expressly states that buyers pay "set sum" toward the purchase ("Gift buyers merely pay a set sum toward the purchase ..."). Thus, like the Ucopia document, Smutko does not contemplate or provide the flexibility of having one buyer contribute \$75.00 toward a gift, while another contributes \$125.00, and another \$80.00, etc. There is nothing in Smutko that would have suggested the modifications to

the Ucopia document proposed in the office action to provide the subject matter of claims 195, 207, 208 and 209.

The office action continues by noting that "Ucopia or Smutko does not expressly show that the commitment of each giver that commits to make a monetary contribution is for any giver-desired portion of the uncommitted balance of the selected gift's purchase price." Office Action, page 7. Thus, the office action acknowledges that this feature of the claims cannot be found in either of the documents used in the rejection of the claims. The office action alleges however that these admitted differences between the applied references and the claims are:

...found only in the nonfunctional descriptive material and are not functionally involved in the steps of receiving commitments or combining the commitments. These steps would be performed the same regardless of the data (i.e. regardless of the attributes of the giver's contribution). Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983), *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

The office action concludes that it would have been obvious to provide the claimed feature "because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention."

Applicant strongly traverses the characterization of the claimed feature of committing to make a monetary contribution for any giver-desired portion of the uncommitted balance of the selected gift's purchase price as "non-functional descriptive material" which "does not functionally relate to the steps in the method claimed." The relevant language specifies characteristics of the claimed commitments and does not constitute non-functional descriptive material.

Applicant also strongly traverses the analysis in the office action purportedly leading to the conclusion that the claimed feature is descriptive material. Specifically, the office action analysis looks to other steps of the method and concludes that because these steps would allegedly be "performed the same" regardless of the attributes of the

giver's contribution, the attributes of the giver's contribution are descriptive material and cannot constitute a basis for distinguishing the claimed subject matter from the prior art.

First, the receiving and combining steps are not performed the same regardless of the attributes of the giver's contribution. For example, in the Ucopia document, a user purchases one or more shares and it is this data that is involved in the receiving and combining operations. This is not the same as in the claimed arrangements in which the receiving and combining steps do not involve numbers of shares.

Second, Applicant is aware of no legal precedent that permits dispensing with the obviousness inquiry if it can be alleged that some method step is "performed the same." The cited cases do not provide a basis for such an approach. Indeed, the "descriptive material" referenced in the *Gulack* and *Lowry* cases is printed matter and these cases discuss whether the printed matter is functionally related to the substrate on which it is embodied. This is clearly quite different than the issues at hand in connection with the pending claims.

In short, the reasoning in the office action regarding descriptive material and the cited cases do not establish the obviousness of the claimed subject matter. Consequently, the rejected claims are allowable over the Ucopia and Smutko documents.

Independent claims 212, 218, 219, 228 specify, among other things, that at least one gift idea from the gift recipient specifies a substitute gift. In the illustrative embodiments of the subject application, this feature enables a gift recipient to specify a substitute gift in the event, for example, the original gift specified in the gift idea is not available for some reason. This substitution feature cannot be found in either the Ucopia document or Smutko and for at least this reason these claims are believed to be allowable over the proposed combination of these references. (As explained in greater detail below, this feature cannot be provided by combining the Ucopia document and Smutko with Linstedt.)

Independent claims 220, 226, 227 and 234 specify, among other things, that each giver can commit for part of the total gift amount specified for a selected gift even if the only gift amount specified by the gift idea for the selected gift is the total gift amount. This feature cannot be found in the Ucopia document or in Smutko and thus any forced

combination of these references would likewise be deficient. In particular, in the Ucopia document, the gift recipient must specify a share amount in order to permit the "group purchase" described therein. The specification of share amount requires the gift recipient to perform an extra step, thereby increasing the time and effort expended to set up the registry. Moreover, retail prices are often of odd amounts, for example, \$979.99 and are not readily divisible into shares. The gift recipient must therefore spend additional time calculating a share amount at which these odd amounts can be divided into equal shares. Since the typical wedding registry may have 50 to 200 items, the additional steps of specifying a share amount and the number of shares for each gift could be quite time consuming. In complete contrast to the system described in the Ucopia document, the arrangements of claims 220, 226, 227 and 234 do not require the extra steps of setting a share amount or a number of shares and thus are more convenient and less time consuming to use.

Furthermore, some gift prices may not be divisible into equal shares at all. If the gift price is equal to a prime number (*e.g.*, \$1,333.37), then it would be impossible to divide the price into equal shares. There are approximately 8,000 "prime number" price points under \$1,000.00 that cannot be split into equal shares. A similar problem arises if some default share amount (*e.g.*, \$50.00) is used. A \$1,333.37 gift cannot be divided into a whole number of equal \$50.00 shares. Here again, in complete contrast to the system described in the Ucopia document, the arrangements of claims 220, 226, 227 and 234 are readily usable for all price points.

Finally, gift recipients typically lack sufficient information to set an optimal share price since they have no idea as to what potential gift givers are willing or are able to spend. If the share price is set too high, too few gift givers will be able to afford the shares. If the share price is set too low, there may be an insufficient number of givers to purchase all of the shares.

For all these reasons, Applicants respectfully submit that claims 220, 226, 227 and 234 cannot be rendered obvious by the proposed combination of the Ucopia document and Smutko.

In addition to the reasons advanced with respect to the claims from which they depend, various dependent claims contain additional patentable features not taught or suggested by the proposed combination of the Ucopia document and Smutko.

By way of example, with respect to claims 204-206, 216, 217, 224, 225, 232, 233, 238 and 239, the office action takes Official Notice of the features of receiving cash if the total of commitments is less than gift's purchase price and of one or more gift ideas being associated with a recipient-determined price or vendor. Should this rejection be maintained, Applicant respectfully requests that documentary evidence be provided to show that these features are known in the context of the claimed invention. For example, there is no disclosure in the cited documents of recipient-determined or specified prices or gift amounts for gift ideas as specified in claims 205, 217, 225, 233 and 239 and Applicant does not understand the concept of a recipient determining a price for a gift idea to be "capable of such instant and unquestionable demonstration as to defy dispute." *See In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). Similarly, there is no disclosure in the Ucopia document, for example, of recipient-determined vendors as specified in claim 206.

In addition, while the Ucopia system provides that incomplete purchases can be given to the registrant in gift certificates, there is no disclosure of providing the commitments for monetary contributions to the gift recipient as cash if the total of the commitments is less than the gift's purchase price as specified in claims 204, 216, 224, 232 and 238. Unlike cash, gift certificates generally (1) can only be used in certain stores; (2) have expiration dates; and (3) are generally non-transferable. Moreover, gift certificates are backed only by the credit of each respective store.

Claims 197, 213, 221, 229 and 235 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the Ucopia document-Smutko combination, in further view of the "weddingchannel.com" document. The weddingchannel.com document is applied as teaching a registry in which web pages are generated and supplied to gift givers. However, the weddingchannel.com document does not remedy the above-noted deficiencies of the proposed Ucopia document-Smutko combination in connection with claims 195, 212, 220, 228 and 234 (from which claims 197, 213, 221, 229 and 235

respectively depend). As such, even assuming for the sake of argument that the combination of these documents would have been proper and that the combination were made, the subject matter of claims 197, 213, 221, 229 and 235 would not result.

Claims 199 and 200 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed combination of the Ucopia document and Smutko, in further view of Ojha *et al.* (U.S. Patent No. 6,598,026). Ojha *et al.* discloses methods and apparatus for facilitating a transaction between a buyer and one of a plurality of sellers via the internet. Ojha *et al.* does not describe gift-giving systems and thus does not, for example, disclose the concept of a vendor sending a gift to a gift recipient as specified in claims 199 and 200. Nor does Ojha *et al.* disclose or suggest the concepts of a gift list or of aggregating purchase requests for identical gifts into a single purchase order. In addition, like independent claim 195, 207, 208 and 209, independent claims 199 and 200 are directed, among other things, to enabling a plurality of gift givers to each make a respective commitment for a monetary contribution of *any giver-desired amount* toward a purchase price of a gift for a gift recipient. Ojha *et al.* does not remedy the deficiencies of the Ucopia document and Smutko with respect to commitments of any giver-desired amount and thus, even if these three references were forcedly combined, the subject matter of claims 199 and 200 would not result.

Claims 203, 215, 223, 231 and 237 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed combination of the Ucopia document and Smutko, in further view of Linstedt. Applicant notes that claims 215 and 231 were previously canceled. Each of claims 203, 223 and 237 (along with claims 212 and 228) calls for a gift recipient to specify a substitute gift. The Linstedt article mentions a shopper who made a list including substitute gifts for shopping on the day after Thanksgiving. This newspaper article has nothing to do with the gift-giving arrangements described in the Ucopia document and Smutko and in no way would have suggested modifying these gift-giving arrangements. In addition, any gift substitutions in newspaper article are expressly attributable to the gift giver, not the gift recipient as specified in the claims. For at least these reasons, claims 203, 212, 223, 228 and 237 are believed to be allowable.

In addition, claims 203, 223 and 237 are believed to be allowable for the reasons set forth with respect to the claims from which they depend.

New independent claims 240-251 are added. These claims are fully supported by the original disclosure and no new matter is added.

Independent claims 240 and 245 each specifies that the amount of the monetary contribution of each commitment toward the uncommitted balance of the selected gift's purchase price is directly specified as an amount of currency which is not constrained by the gift parameters specified for the selected gift. This feature is not taught or suggested by the applied references. For example, in the Utopia document, the user cannot directly specify an amount of currency and the commitment of each giver that commits toward the purchase of a gift is constrained by the share price parameter specified for that gift.

The dependent claims 241-244 and 246-249 and new independent claims 250 and 251 recite various gift substitution features which are in no way disclosed or suggested by the cited documents.

Applicant submits that the pending claims are in condition for allowance, and action to that end is earnestly solicited.

Respectfully submitted,

**NIXON & VANDERHYTE P.C.**

A handwritten signature in cursive script, reading "Michael J. Shea", written over a horizontal line.

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